

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Hiroshi Yoshikawa et al. **Examiner:** Michael P. Alexander
Application 10/636,150 **Confirmation** 1804
Filed: August 7, 2003 **Group Art** 1742
For: **METHOD AND DEVICE FOR FORMING A DYNAMIC PRESSURE-GENERATING GROOVE IN A FLUID DYNAMIC PRESSURE BEARING**

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is a Response to the Restriction Requirement of June 27, 2005 for the above-identified patent application.

FEE FOR ADDITIONAL CLAIMS

- ☒ A fee for additional claims is not required.
☐ A fee for additional claims is required.

The additional fee has been calculated as shown below:

	Claims Remaining After Amendment	Highest Number Previously Paid For	Present Extra	Rate	Additional Fee
Total Claims	0	- 0	= 0	x \$50.00	= \$0.00
Independent Claims	0	- 0	= 0	x \$200.00	= \$0.00
First Presentation of a Multiple Dependent Claim				+ \$360.00	= \$0.00

TOTAL = \$0.00

- ☐ A check in the amount of \$XXX in payment of the fee for additional claims is transmitted herewith.
- ☒ The Commissioner is hereby authorized to charge payment of any additional fees required under 37 C.F.R. §§ 1.17 and 1.20 in connection with the paper(s) transmitted herewith, or credit any overpayment of same, to Deposit Account No. 50-0675, Order No. 051319.0045. A duplicate copy of this transmittal letter is transmitted herewith.
- ☐ Please Charge \$XXX to Deposit Account No. 50-0675, Order No. 051319.0045 in payment of the fee for additional claims. A duplicate copy of this transmittal letter is transmitted herewith.

EXTENSION FEE

- ☐ The following extension fee is applicable to the Reply filed herewith: \$XXX extension fee for response within XXX month(s) pursuant to 37 C.F.R. § 1.136(a).
- ☐ A check in the amount of \$XXX in payment of the extension fee is enclosed herewith.
- ☒ The Commissioner is hereby authorized to charge payment of any additional extension fee required under 37 C.F.R. § 1.17 in connection with the paper(s) transmitted herewith, or credit any overpayment of same, to Deposit Account No. 50-0675, Order No. 051319.0045. A duplicate copy of this transmittal letter is transmitted herewith.
- ☐ Please charge \$XXX extension fee to Deposit Account No. 50-0675, Order No. 051319.0045. A duplicate copy of this transmittal letter is transmitted herewith.

Respectfully submitted,

Schulte Roth & Zabel LLP
Attorneys for Applicant(s)
919 Third Avenue
New York, NY 10022
212-756-2000

Dated: July 27, 2005
New York, New York

By: 

Reine Glanz, Esq.
Reg. No. 46,728

CERTIFICATE OF MAILING

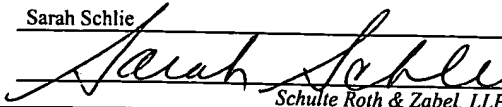
Date of Deposit: July 27, 2005

I hereby certify under 37 C.F.R. 1.8 that this correspondence and enumerated documents are being deposited with the United States Postal Service as First Class Mail with sufficient postage on the date indicated above and is addressed to Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Name:

Sarah Schlie

Signature:


Schulte Roth & Zabel, LLP



Docket No.: 051319-45

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Hiroshi Yoshikawa et al.

Serial No.: 10/636,150

Filed: August 7, 2003

For: **METHOD AND DEVICE FOR FORMING A DYNAMIC
PRESSURE-GENERATING GROOVE IN A FLUID DYNAMIC
PRESSURE BEARING**

Examiner: Michael P. Alexander Group Art Unit: 1742

Date of Deposit: July 27, 2005
I hereby certify that this paper or fee and enumerated documents is
being deposited with the United States Postal Service "First Class Mail
service under 37 CFR 1.8 on the date indicated above and is addressed
to Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O.
Box 1450, Alexandria, VA 22313-1450

Sarah Schlie
Sarah Schlie

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT OF JUNE 27, 2005

Sir:

This is in response to the Restriction Requirement of June 27, 2005, on which the shortened statutory period for response expires on July 27, 2005. Accordingly, this Response is timely filed.

In response to the Restriction Requirement, Applicant elects Group I (Claims 1-3), with traverse.

Applicant traverses the Requirement for Restriction between Groups I and II because the facts, as stated by the Examiner, do not meet the legal requirements for a proper Restriction.

MPEP §803 states the requirements for a restriction requirement:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05 - § 806.05(i)); and
- (2) There must be a serious burden on the examiner if restriction is not required (see MPEP §803.02, §806.04(a)-(j), §808.01(a) and §808.02).

MPEP §806.05(e) clarifies that

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (A) that the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another and materially different process.

If the apparatus claims include a claim to "means" for practicing the process, the claim is a linking claim and must be examined with the elected invention.

Independent Claim 4 of the present invention recites "means for imparting an electrochemical dissolving effect to each machined surface of multiple workpieces, each of said workpieces serving as a part of said fluid dynamic pressure bearing; and means for forming at least one fluid dynamic pressure groove on said each machined surface, said groove having a specified shape, dimension and surface condition." Therefore, Claim 4 and its dependent Claims 5 and 6 are at least linking claims and should be examined with the elected Claims 1-3.

MPEP §803 further clarifies (emphasis added):

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The Examiner's paper omits any mention of criterion (2) — the Restriction raises no showing of a serious search burden. At a minimum, a Restriction Requirement without such a showing is incomplete.

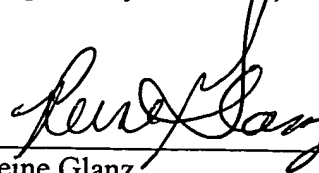
Applicant suggests that the search burden is unlikely to be "serious" when all limitations of Claim 1 (the independent claim of Group I) appear nearly word-for-word in Claim 4 of Group II. Claim 1 will be searched in any event. Therefore, it seems that a search of Group I will necessarily result in a search of the independent claim of Group II as well.

In view of the lack of "serious burden," Applicant requests that the Restriction between Groups I and II be withdrawn or the claims be at least examined together as required by MPEP 806.05(e).

Should the requirement for restriction be made final, the Examiner is respectfully requested to state on the record that the claims in each group are patentable (novel and nonobvious) over each other.

The Examiner is urged to telephone Applicant's counsel of record at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-0675, Order No. 051319-45.

Respectfully submitted,



Reine Glanz
Reg. No. 46,728
Schulte Roth & Zabel, LLP
919 Third Avenue
New York, NY 10022
Tel. (212) 756-2000

Date: July 27, 2005